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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,164

07/13/2006

Kwang-Sik Kim

2017-097

7020

52706

7590

04/03/2009

IPLA P.A.

3580 WILSHIRE BLVD.

17TH FLOOR

LOS ANGELES, CA 90010

EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

04/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,164	<b>Applicant(s)</b> KIM ET AL.	
	<b>Examiner</b> Kyle Grabowski	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/13/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1 and 4-7 are objected to because of the following informalities: There is not proper antecedent basis for "the envelope". Every recitation will be construed to mean "the binder envelope". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson (US 6,316,081).

4. In respect to claim 1, Nelson discloses a binder envelope 10 configured to be inserted into a binder (Fig. 10) and made of a transparent material (Col. 4, 53-55) having both a binding portion 12 and a paper storing portion 14 (Fig. 1); bands 16 are attached to the front surface of the binder envelope 10 to store paper.

5. In respect to claims 2-3, Nelson further discloses a vertical row having an upper horizontal band attached to an upper portion of the binder envelope, a lower horizontal

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band attached to a lower portion of the binder envelope, and a middle horizontal band located between the upper and lower bands; all bands are secured with left and right attachments lines and a lower attachment line, leaving opening 23 on the tops thereof (Col. 5, 3-20, Fig. 1); Nelson does not disclose that the bands were attached by a "thermal adhesion method" however, although product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

6. In respect to claim 4, Nelson further discloses left and right vertical bands, four in a first row and four in a second row, each having a predetermined width and length and being longitudinally attached to portions near the right and left edges of the front surface of the binder envelope 10 (Fig. 1).

7. In respect to claim 7, Nelson further discloses: an upper horizontal edge band (e.g. the uppermost and left band 16, Fig. 1) attached to an upper edge of the binder envelope 10 having vertical right and left attachment lines as described above; and a lower horizontal edge band (e.g. the lowermost and left band 16, Fig. 1) attached to a lower edge of the binder envelope 10 having vertical right and left attachment lines and a lower attachment line as described above

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8. In respect to claim 8, Nelson further discloses that ink receptive layers 20 (which are exterior to the pockets 16, Col. 3, 51-52) may be adjusted to allow for black and colored jet ink (Col. 7, 42-44).

9. Additionally, the examiner would like to further convey to the applicant that the nomenclature of the claims pertaining to the bands and their location are broad and drawn substantially to subjective directional references without much structural recitation. As such, claims 2-4 and 7 are all each separately rejected as anticipated by the same bands 16 disclosed in Figure 1, depending on their reasonable broad interpretation.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 6,316,081) in view of Werner et al. (US 5,709,496). Nelson substantially discloses the claimed subject matter for the reasons stated above including a single pocket which substantially extends to the corner extents of the binder envelope (Fig. 3) but does not disclose corner bands, particularly of a triangular shape however Werner et al. disclose a similar binder envelope 10 which utilizes corner bands 50 which are arranged in diagonal directions from each other and aligned along their vertexes (Fig. 4) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the band as taught in Nelson (Fig. 3) with the corner bands taught in Werner et al. as a suitable known alternative. All of the claimed elements were known in prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Providing the one band embodiment Nelson (Fig. 3) with the corned band configuration results in the corned bands being disposed in corners of the binder envelope.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-

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3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/  
Examiner, Art Unit 3725

/Dana Ross/  
Supervisory Patent Examiner, Art  
Unit 3725